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10/769,970	02/02/2004	Thomas J. Prorock	RPS920030156US1/2919P	9128
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IBM RP-RPS SAWYER LAW GROUP LLP 2465 E. Bayshore Road, Suite No. 406 PALO ALTO, CA 94303			EXAMINER BROWN, ALVIN L	
			ART UNIT 3622	PAPER NUMBER
			NOTIFICATION DATE 05/14/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@sawyerlawgroup.com

Office Action Summary

Application No.

10/769,970

Applicant(s)

PROROCK ET AL.

Examiner

ALVIN L. BROWN

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 2-6 have been canceled. Claims 1 and 8 have been examined.

Response to Amendment

2. The amendment filed on 22 December 2008 is insufficient to overcome the prior art rejection.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (6,837,428) in view of Trika et al. (2005/0131761) further in view of Rando et al., (5,128,520).**

As per claim 1 Lee discloses a method for processing coupons by a self checkout system, wherein the self checkout system comprises at least one self checkout station coupled to a server, the method comprising:

receiving a coupon from a customer, wherein the coupon is a paper coupon that is fed into a coupon reader of the at least one self checkout stations (Fig. 7; column 12-61);

attempting to validate the coupon against at least one item scanned by the customer after the couple reader receives the coupon from the customer (Fig. 11; column 7, line 52 – column 8, line 11);

collecting tracking information related to the coupon and storing the tracking information in a coupon tracking file at the server Column 7, lines 12 – 44);

transmitting the electronic coupon from the one self checkout station to the server (column 6, line 63 – column 7, line 44);

Lee further discloses scanning coupons using a UPC scanner (Fig. 7, column 7, lines 12- 61); converting the paper coupon into an electronic coupon.

Lee does not explicitly disclose converting a paper coupon into an electronic coupon;

storing the electronic coupon into one of two coupon pools at the server if the coupon fails to validate against the at least one item, wherein one coupon pool is a global pool having coupons stored in the global pool which are accessible by all customers, wherein the other coupon pool is a personal pool that is associated with the customer such that coupons stored in the personal pool are accessible only by the customer, wherein the tracking information comprises the coupon pool in which the coupon is stored, wherein the stored electronic coupon can be utilized at a subsequent sales transaction, wherein the global pool allows the second customer to search the global pool for a coupon that validates against an item scanned by the second customer during the subsequent sales transaction, wherein the global pool allows a second customer in the subsequent sales transaction to utilize the coupon, wherein a value of the coupon is deducted from a price of the item if the coupon and the item are validated, and wherein the personal pool allows the customer to access the global pool, select at least one coupon in the global pool, and transfer the selected coupon to a personal

account at the server; wherein the global pool, personal pool, and coupon tracking file are each stored in a separate location at the server; allowing the customer to search one or more of the global pool and the personal pool for coupons that can be applied to any scanned items by the customer.

However, Trika teaches scanning a printed coupon in order to convert it to an electronic coupon (paragraph [0020]);

storing the electronic coupon into one of two coupon pools at the server if the coupon fails to validate against the at least one item, wherein one coupon pool is a global pool having coupons stored in the global pool which are accessible by all customers, wherein the other coupon pool is a personal pool that is associated with the customer such that coupons stored in the personal pool are accessible only by the customer, wherein the tracking information comprises the coupon pool in which the coupon is stored, wherein the stored electronic coupon can be utilized at a subsequent sales transaction, wherein the global pool allows the second customer to search the global pool for a coupon that validates against an item scanned by the second customer during the subsequent sales transaction, wherein the global pool allows a second customer in the subsequent sales transaction to utilize the coupon, wherein a value of the coupon is deducted from a price of the item if the coupon and the item are validated, and wherein the personal pool allows the customer to access the global pool, select at least one coupon in the global pool, and transfer the selected coupon to a personal account at the server; wherein the global pool, personal pool, and coupon tracking file are each stored in a separate location at the server; allowing the customer to search

one or more of the global pool and the personal pool for coupons that can be applied to any scanned items by the customer (Figure 2, paragraphs [0017, 0022-0025, 0029-0032, 0035-0036] A coupon can be stored locally on a user's system and be coded as non-shareable, in this case that infers personal pool. While in other described embodiments coupons may be stored on a server to be shared with other users inferring a global coupon system).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Trika's converting paper coupon to an electronic coupon and storing a coupon in global and personal account to Lee's coupon processing. One would be motivated to do this in order to increase the usage of coupon among consumers.

Lee does not explicitly disclose allowing the customer to choose whether to store the invalidated coupon, if the customer chooses to store the invalidated coupon;

destroying the paper coupon after the paper coupon has been converted into an electronic coupon.

However, Rando teaches returning an invalid coupon to the customer (Figure 1); and

destroying the paper coupon after the paper coupon has been converted into an electronic coupon (column 3, lines 49 – 57; column 9, lines 54- 58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Rando's allowing a customer to choose to store an invalid coupon and destroying a paper coupon to Lee's coupon processing. One would

be motivated to do this in order to increase the usage of coupon among consumers and reduce the chance of fraud in the system.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (6,837,428) in view of Trika et al. (2005/0131761) further in view of Rando et al., (5,128,520) further in view of Mastrianni et al., (2007/0156513) in further view of Goodwin, III et al., (6,696,920).

As per claim 8, Lee does not explicitly disclose receiving the tracking information in the coupon tracking file, accessing the global pool at the server by the item manufacturer, selecting at least one coupon in the global pool

However, Trika discloses receiving, by the item manufacturer, the tracking information in the file by an item manufacturer, accessing, by the item manufacturer, the global pool at the serve, selecting, by the item manufacturer, at least one coupon in the global pool (paragraphs [0030]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Trika's accessing the manufacturer server to Lee's coupon processing. One would be motivated to do this in order to increase the usage of coupon among consumers and reduce the chance of fraud in the system.

The Lee, Trika and Rando combination does not explicitly disclose analyzing, by the item manufacturer, the tracking information for the selected coupon;

modifying, by the item manufacturer, the selected coupon by modifying a price of the item based on the analysis and by modifying an expiration date of the selected coupon; and

implementing, by the item manufacturer, the modified price immediately via an electronic shelf label associated with the item.

However, Mastrianni teaches a manufacturer modifying a coupon's price and expiration date based on analysis (paragraphs [0013, 0037, 0045]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Mastrianni's to manufacturer modification of price and expiration date to Lee's coupon processing. One would be motivated to do this in order to provide a manufacturer with flexibility and the ability to react quickly to market analysis in their coupon programs.

The Lee, Trika and Rando combination does not explicitly disclose implementing the modified price immediately via an electronic shelf label associated with the item.

Goodwin, teaches a method of changing an electronic price label display sequence with the step for implementing the modified price immediately via an electronic shelf label associated with the item (column 2, lines 63 through column 3, lines 1 – 6)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Goodwin's implementation of changes in price and expiration date to Lee's coupon processing. One would be motivated to do this in order to provide a manufacturer with flexibility and the ability to react quickly to market analysis in their coupon programs.

Response to Arguments

3. Applicant's arguments filed 22 December 2008 have been fully considered but they are not persuasive. Examiner had two meetings with Supervisor and Primary to discuss the patentability of the claims. As a result, there are several recommendations the applicant should consider in order to move this application forward. Using the broadest reasonable interpretation, the "if" statement and features that are part of the "if" statement in claim 1 are optional and should be amended in other that the claim may be positively recited and also for logical clarity. Also, with the "if" statement being optional, the current prior art rejection reads on the broadest reasonable interpretation of independent claim 1.

Additionally, dependent claim 8 does not need to be moved into claim 1 in order to move this application forward.

Examiner respectfully notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Note, as stated above, that the claims can be interpreted in different ways because of the broad disclosure of the claims. Examiner notes that claims are given their broadest reasonable construct. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN L. BROWN whose telephone number is (571)270-5109. The examiner can normally be reached on Monday - Thursday 7:30 AM to 5:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571 272 6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 3622

ALB

/Arthur Duran/
Primary Examiner, Art Unit 3622